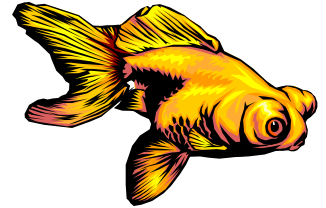
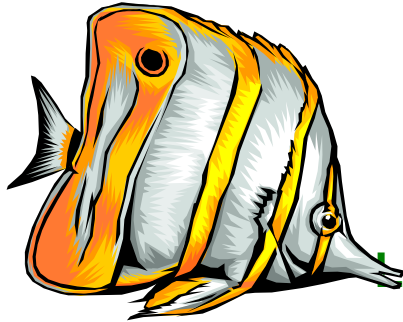


Annual Meeting 2002:

The Cyberspace Law Committee of the Business
Law Section Presents:
Cyber Space Odyssey 2002



Famous People, Trademarks
and Domain Names



Philip R. Green

Law Offices of Green & Green



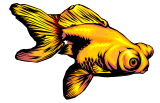
Overview

- Trademark Basics
 - Registration benefits
 - Strong & Weak Marks
 - Surnames
- Trademark as Domain Names
 - Exporting the 1st Amendment?
 - FORUMS:
 - US law vs. International Forums
- Interplay between UDRP and ACPA
 - Infringement
 - Famous Names – Springsteen Case
- Conclusions and Best Practices



Registered Trademarks carry more weight

Registrations are down in 2002 –
The good news: It takes less time...



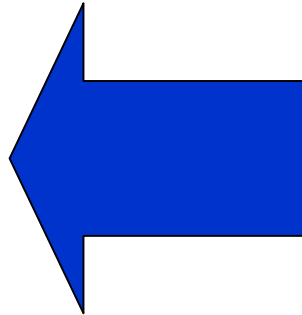
- USE a mark in IN COMMERCE or INTERNATIONALLY (U.S. only!)
- Register TMs all other places. (use examining registers not Tunisia- Madonna Case)
- Use of WWW & Domain Names to do immediate national and international advertising.
- Forum: UDRP and/or ACPA

****Do Not use “®” until registered!***

Fanciful to Descriptive

□ Fanciful: Strongest marks

- Not Descriptive Marks to be Registered should be Fanciful on a spectrum from “**Xerox**”- “**KODAK**” –
- Can be registered on U.S. Principal Register



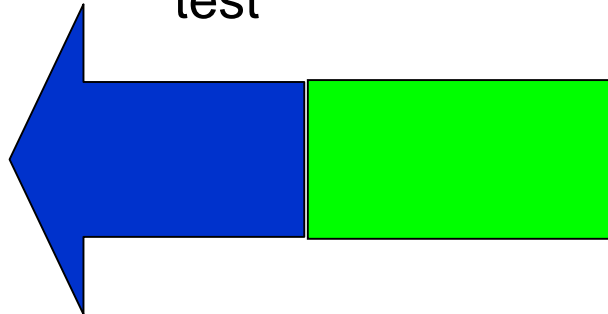
Fanciful to Descriptive

□ Suggestive: Weak but Registrable

■ Not Descriptive but close to it:

“MOVIEBUFF” for a database of movie information*

■ Needs test - Imagination test –Competitors Use test



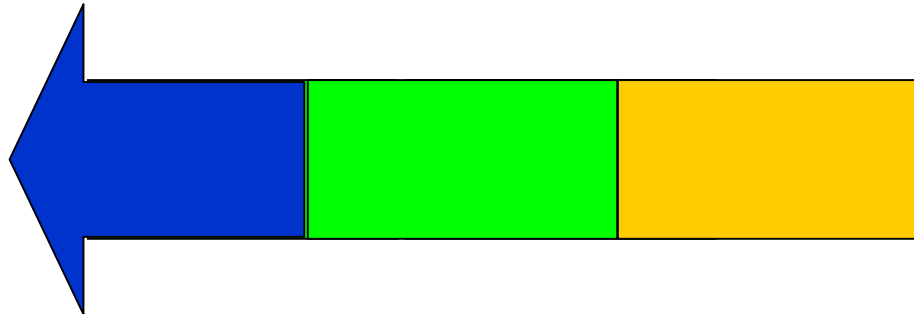
Brookfield Communications, Inc. v. West Coast Entertainment Corp., (9th cir. 1999)

174 F.3d 1036, 1058, 50 U.S.P.Q.2d 1545, 1561

Fanciful to Descriptive

□ Descriptive: Not usually Registrable

- Usually cannot be registered on U.S. Principal Register – maybe after time & Secondary Meaning
- Celebrity names treated as if descriptive of person
 - Series of goods , Sec 2(f) (Distinctive) Secondary Meaning exceptions.

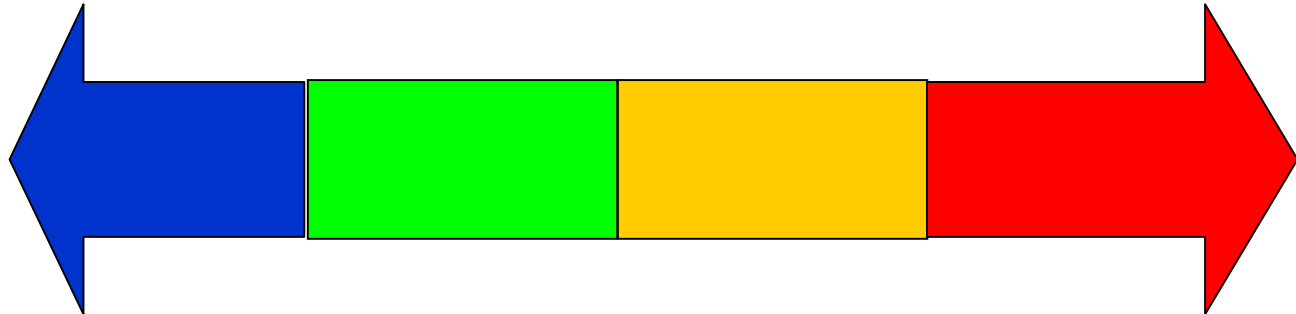


*(In re Omaha Nat'l Corp., (Fed. Cir. 1987)
819 F.2d 1117, 2 U.S.P.Q.2d 1859).

Fanciful to Descriptive

- Generic & Geographically –
Descriptive / Misdescriptive:
Weakest “Geographical”

- Usually cannot be registered in U.S.–maybe
after a LONG time & Secondary Meaning



Domain Name as a Trademark...

P.T.O. and TM.Com

- **As an address**, a Domain Name does not serve to indicate source.
 - Attorney who used his “www...” on letterhead among his addresses does not make of it an acceptable “use.” as a source identifier for legal services, it is *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).
- **Advertises Applicant’s own services** is not itself a “service.”
 - Use of a DOTCOM...”for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity.” *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970); TMEP §1301.01(a)(ii)

Personal Names as Trademarks

□ SURNAMES

- If a mark is composed of a surname and a TLD, the mark is primarily merely a surname under 15 U.S.C. §1052(e)(4).
- A TLD has no trademark significance.
- If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname.

□ P.T.O. Policy on Person's Names:

- **Abba Case: *IN RE POLAR MUSIC INTERN. AB*, 714 F.2d 1567, 221 U.S.P.Q. 315 (C.A.Fed.,1983.)** “ABBA” used on albums – was not the *source* the record company is deemed the source of the GOODS.
 - Name of group ...merely identifies *the Band*: ... “applicant has done no more than show the name of the recording group, “TOYZ”, on a record cover. Such a showing “* * * will not by itself enable that name to be registered as a trademark.”
 - *In re Peter Spirer* 225 U.S.P.Q. 693 P.T.O. (T.T.A.B. Feb. 27, 1985)
- Must use on *series* of goods and
- Be used as the *source* identifier and not just the name of the person.
 - Proof: Agreement with Record Company showing it was only a manufacturer and distributor.
- Affects whether a name can be *registered*.

□ Full Story, Get: P.T.O. Examination Guide No. 2-99 September 29, 1999 online at www.uspto.gov

□ VINCE GUARALDI® FOR CLASS 09 RECORDINGS REGISTERED 2002

- Over 25 years after the Famous “Charlie Brown” Cast Your Fate to the Wind Jazz composer & musician died.



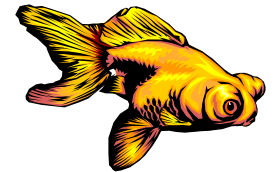
U.S. – EU: USE vs. Registration

□ U.S. Trademarks:

- **Right by USE under Lanham Act**
- Trademarks represent the Good Will of the Name to the Consumer.
- Internet Domain Names behave like Trademarks
 - Courts do not always treat Domain Names like Trademarks
- Searches MUST include “Common Law”

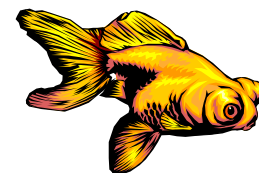
□ EU- **FIRST TO REGISTER**

- **U.S. ALLOWS ITU** applications for near - filing date use
- Rest of World => Register the mark



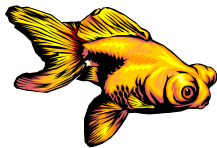
Trademark Prosecutions can Alter Domain Name rights...

- A registered Trademark is more likely to prevail over an unregistered mark
 - But a mere unexamined “**otc**” registration from Tunisia may not be recognized to defeat the famous.
 - *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847 Case No. WIPO D2000-0847 **October 12, 2000**
- If P.T.O. denies or opposes registration there is a Prosecution History in the *File Wrapper*: evidence either side may use.
 - If a mark was not registered or “Actioned” because it was
 - **Generic**
 - **Descriptive** or
 - **Geographical**
 - It may lose a UDRP action.
- Standards for “Confusingly Similar” differ from USA to UDRP
 - UDRP uses no standard U.S. uses Case law tests: *Sleekcraft* Factors
 - *AMF v. Sleekcraft* 204 U.S.P.Q. 808 (9th Cir, 1979)



Exporting the First Amendment? Sucks sites

- **SUCKS websites may be legitimate comment**, criticism - Exporting the 1st Amendment?:
 - Prepare to defend your GOOD NAME
- Defamatory statements are protected
 - Savin Copiers unable to “get” SavinSUCKS.COM:
 - The “bad faith” in the Policy have at least one element in common: ... that the respondent, at the time the domain name was registered, harbored an ***intent that related in some manner to the complainant or its trademark.***
 - Savin Corporation v. savinsucks.com (Claim Number: FA0201000103982 **March 5, 2002**)
 - The Panel: “Although Complainant’s **trademark rights** are valid, they are nonetheless **limited by the Respondent’s First Amendment rights**. Under the First Amendment of the United States Constitution, **Respondent has an unfettered right to hold or express his opinion ...that ‘Savin Sucks’...**”



Exporting the First Amendment? UDRP

- NO 1st Amendment in UDRP – WIPO panel limits use: in transferring wal-martcanadasucks.com to the complainant, “The Panel ... decision does not address *legitimate freedom of expression sites* ... [do not] characterize this decision as seeking to stifle freedom of expression ... by ordering the transfer of "sucks" formative names. ...this decision to serve[s] neither ...aim. This decision is directed to a blatant abuse of the domain name registration process -- no more, no less.”
 - The panel found the use was commercial, and “not within the scope of fair use or legitimate noncommercial use permitted by paragraph 4(c)(iii) of the Policy”
 - Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico, (July 20, 2000) WIPO Case No. D2000-0477

Courts may use foreign law against U.S. user, and U.S. law against a Foreign Judgment...

- **Barcelona.Com, Inc. v. Excelentísimo Ayuntamiento de Barcelona**
2002 WL 359759 E.D.Va. (Feb. 22, 2002)
 - Cannot use name of European cities even with a legitimate travel business aimed at boosting tourism there.
 - Court not bound by an ICANN decision and
 - *U.S. Court Followed Spain law* to determine bad faith & Trademark validity, where mark was registered:
 - First to properly *register a trademark* is the only legally authorized user.
 - The Defendant had no right to use the first-registered mark under Spanish law and thus the use and attempts to sell were bad faith.
- **Yahoo and the unwanted memorabilia**, Yahoo! V. La Ligue Contre Le Racisme Et L'Antisemitisme, C-00-21275 JF19
 - 1st amendment will protect US version of services aimed at the world from the effect of a French court ruling if to enforce the order would be abhorrent to the Constitution.

Domain Names 2003: Working a Balance

□ **Internet Changed the Trademark Rules**

- Instant “use” and worldwide publication of Trademarks
- NSI had instant litigation and invented 1st Domain Name Resolution system.
- UDRP under ICANN followed – better but criticized.

□ **Domain Names** are not easy to obtain & keep: (Corninthians.com)

- Lost to U.S. poster on WWW of biblical passages
 - Corinthians Licenciamentos LTDA v. David Sallen, Sallen Enterprises, and J. D. Sallen Enterprises Case No. D2000-0461
- Gained back in ACPA- Dec. Action.

□ **Playing field** increases .BIZ*

- * Predict that the “.COM” will remain most popular and sales of other and new TLDs will be slack.
- BIZ “STOP ¹” procedure similar to UDRP

¹ Start-up Trademark Opposition Policy

If you are Famous: UDRP vs. ACPA or both...

- First Amendment & Right of Publicity Play Roles in U.S. - Based and UDRP cases involving US litigants.
- UDRP Does Not have to use any particular law
 - It is suggested a BEST PRACTICE: define what law an arbitrator applies in contract.
 - Rollerblade® + ing = verb is “generic” as used by the Respondent thus weak Trademark rights.
 - *Rollerblade, Inc. v. CBNO*. [rollerblading.com] Case No. D2000-00427 August 24, 2000
 - Unusually large amount of other case citations – be in control, explain the law you will use and how it applies or arbitrator may supply what they know best.
 - Use of law of both countries where litigants from US and Switzerland Isabelle Adjande
- UDRP: Shop for Arbitrator Panels Carefully
 - Arbitrators can be arbitrary
 - Use contract terms to specify Law and Details of ADR
 - Review Past decisions by arbitrators
 - SEE: www.incann.org

Relationship Between Trademarks and Domain Names

- Domain Name is international.
 - Trademark only viable in country where it is registered. *No extraterritorial effect.*
 - **NEW**: Madrid Protocols allow for international registrations. Congress is working on it.
- Domain Name Capable of identifying source of a web site.
 - Trademark identifies source of goods/services.
- Domain Names are all unique BUT FOR the TLD (the dotcom-dotnet-dotinfo-dotBIZ).
 - Trademarks can be identical but if on different goods, they can both be registered.
 - P.T.O. - Domain Names as Reg'd Trademarks – analogous to an 800-number.

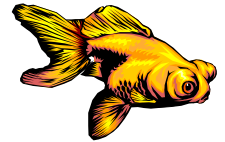
Interplay between UDRP and ACPA

Sanctions for Too Many Cases:

- ***Storey v. Cello Holdings, L.L.C.* (S.D.N.Y.,2002) 182 F.Supp.2d 355** attorney held for sanctions, attorney fees and coverage of Court costs. Cello Company Limited sued Storey for the Domain Name it wanted. The Cello attys advised the Court it had settled, though it was only discontinued by Cello.
- Later Cello complained under UDRP to eResoulution.
- Then, *while the ADR was pending*, Cello filed complaint in New York for the Domain Name asking for a Declaratory Judgment that Storey was not in bad faith. The eResolutiun Panel held for Cello and the New York action was dismissed for lack of merit regarding the word Cello as a Trademark.
- Attorneys misrepresented the nature of the “dismissal” & they had a pending case in Court while filing the UDRP claims.
- Because the proceedings were almost identical in the UDRP and original actions, “--for precisely the same reasons--the alleged confusion between Cello's mark "Cello" and "cello.com.”
 - Cello was barred from reasserting its claims in the arbitration proceedings.
 - The bottom line of this is do not attempt to use UDRP as a substitute for a Court action.

Interplay between UDRP and ACPA

Declaratory Relief and ACPA as Appeal from UDRP



- ICANN waits - 10 days to file
- Dec. Action to Repair UDRP errors:
 - 15 U.S.C. § 1114(2)(D)(v) – ACPA - Reactivation
 - If registrar cancels or transfers a Domain Name based on knowing misrepresentation in a UDRP action,
 - A civil action for costs, attorney fees and to have reactivation of the domain name or transfer of the domain name back to the Respondent.
 - 28 U.S.C. § 2201 - Declaratory Judgment (DJ) Actions
 - “...declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought.” For Declaration that use of Domain Name is not unlawful as a final judgment.
 - SALLEN v. CORINTHIANS LICENCIAMENTOS LTDA No. 01-1197 U.S.C.A. 1st DIST MASS. (Dec. 5, 2001)
 - Overturned a UDRP-ICANN ADR Ruling to RETURN a Domain Name to a registrant / former Respondent in the UDRP action.

UDRP Rules: Paragraph 4(a)

Basic Elements

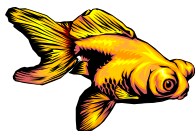
- Paragraph 4(a) of the Policy directs that the complainant must **prove each** of the following:
- (i) that the domain name registered by the respondent is **identical or confusingly similar to a trademark or service mark** in which the complainant has rights; and,
- (ii) that the **respondent has no legitimate interests** in respect of the domain name; and,
- (iii) that the domain name has been registered and used in **bad faith**.

UDRP Rules: Paragraph 4(a)(iii) – Bad Faith Use

- “...Without limitation, -- shall be evidence of the registration and use of a domain name in bad faith:
- (i) circumstances indicating ... you have ... acquired the domain name **primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or**
 - (i) to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
 - (ii) Pattern of registering domain names **in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name;** or
 - (iii) you have registered the domain name **primarily for the purpose of disrupting the business of a competitor;** or
 - (iv) using the domain name, you have **intentionally** attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by **creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location** or of a product or service on your web site or location.”

UDRP: Famous Names may not fare well: Arbitration can be arbitrary...

- *Bruce Springsteen -v- Jeff Burgar and Bruce Springsteen Club* Case No. D2000-1532.
 - The panel “under 4(b)(ii) of the UDRP held that the registration of the Domain Name had to prevent the owner of a trade mark or service mark from reflecting the mark “in a corresponding domain name“... Bruce had been able to register a “.NET” version, he lost.
 - Criticism: It may not be good faith to use the ONLY “.COM” available because Users might believe the “COM” to be the true official site for an artist. See: *Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Burgar operating or carrying on business as Celine Dion Club*, Case No. D2000-1838
 - **BEST PRACTICE: Gather and be ready to present ALL evidence you have on trademark rights and use!**





Pam@Photographer.org

Robin@Smith.net

Jeff@BeHappy.com

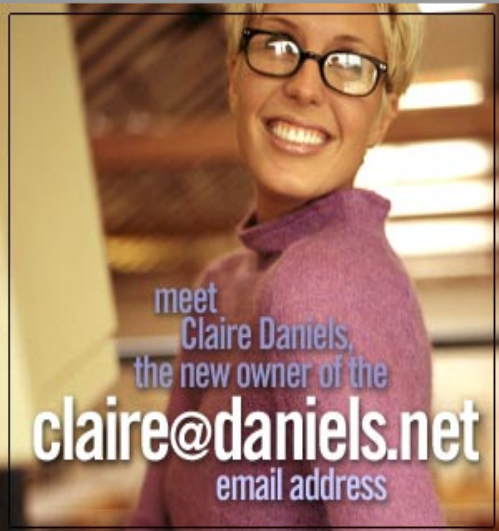
Johnson

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UDRP: Famous with Teeth

Madonna – lots of proof, different panel and continuing, well used, ®registered trademarks makes a difference.

- Respondent here asserted use of a “dictionary word”, and the panel agreed there is another use of the name.
 - We find instead that name was selected and used by Respondent with the intent to attract for commercial gain Internet users to Respondent’s web site by trading on the fame of Complainant’s mark. His Tunisia registration of no moment
 - *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847 Case No. WIPO D2000-0847 **October 12, 2000**

□ **Garth Brooks with ®eg’d Trademarks**

- simply operating a “fan-site” is a no-no without proper linking, Name & likeness, Trademark and other licenses:
 - While the Respondent has not yet attempted to sell the site, it is or has been in the line of business of selling Domain Names.
 - “... given the nature of Respondent’s other businesses in the business of the brokerage and registration and sale of domain names, it is *reasonable to infer that Respondent registered the domain name with the intent to attract Internet users for commercial gain.*”
 - *Garth Brooks v Commbine.com, LLC* WIPO Claim Number: FA0011000096097. **January 3, 2001**

Famous – Political Religious & Wealthy under UDRP

□ KennedyTownsend - Political Fund raising is not Commercial Use

- WIPO: "...protection of an individual politician's name no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set forth in the...Report."
- WIPO 2nd Report: Policy on famous names that if the name did not itself raise funds or have commercial activity, it cannot be given Trademark rights.
 - NO alter-ego in political Complainant and her fund raising corporations. Only the "Friends of" should file since it is the fund raising entity.
 - *KennedyTownsend v. Birt* WIPO D2002-0030 4/11/02

□ Gerry Falwell - religious but no Commercial Use

- "Persons who have gained eminence and respect, but who have not profited from their reputation in commerce, may not avail themselves of the UDRP to protect their personal names against parasitic registrations. The UDRP is thus perceived by some as implementing an excessively materialistic conception of contribution to society." Second WIPO Report, paragraph 199.
- Because Rev. Falwell is careful to use his name connected with Charities, not deemed commercial, he loses.
- *The Reverend Dr. Jerry Falwell and The Liberty Alliance v. Gary Cohn*, WIPO Case No. D2002-0184

□ Ted Turner - famous but he is a "one-off category"

- Ted Turner is a surname and not a Trademark – thus the name tedturner.com is up for sale.
- there is insufficient evidence that his personal name has been used commercially – though is name is a name for "personal name of a well-known businessman."
- as a trademark to promote goods and services other than to use his name IN another mark (Ted Turner Film Properties)
- *R. E. 'Ted' Turner and Ted Turner Film Properties, LLC v. Mazen Fahmi* WIPO Case No. D2002-0251 July 4, 2002



Back



Forward



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Home



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History



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KATHLEEN KENNEDY TOWNSEND FOR GOVERNOR???

Kathleen Kennedy Townsend
Next Governor?

IS SHE READY FOR PRIME TIME?

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File Edit View Favorites Tools Help

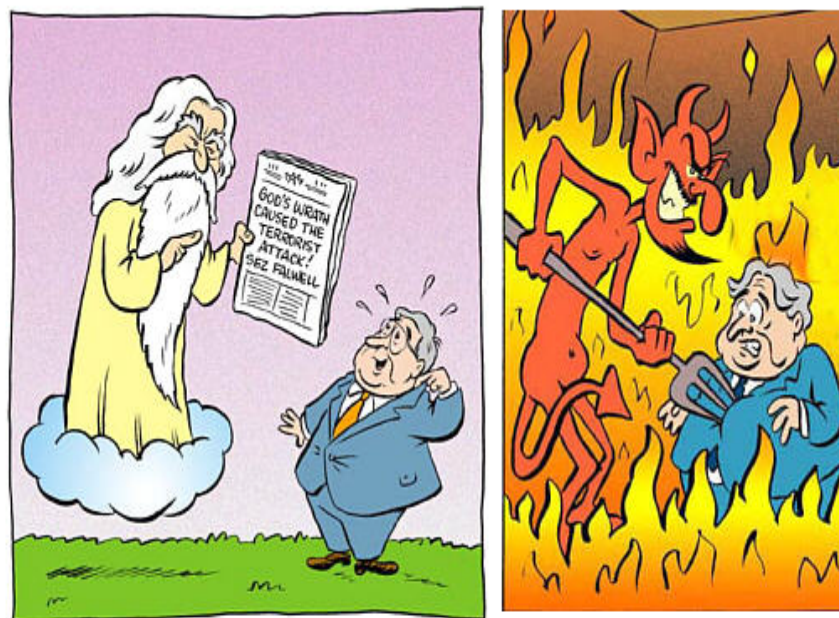
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Address <http://www.internetparodies.org/>

Go Links

[God lifts veil of protection from Jerry Falwell](#)

[Click here to get the whole story](#)



[False prophet Falwell loses legal battle over this parody website](#)

054742

U.S.A.: Anticybersquatting Consumer Protection Act Elements:

■ Best for U.S. Domain Names:

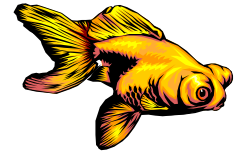
- Original Action
- Money Damages
- UDRP appeals and
- Declaratory Relief Actions

■ ELEMENTS:

- One who “Registers, **traffics** in, or uses a domain name of a **mark that is distinctive** at the time of registration of the domain name that is **identical or confusingly similar** to that mark **or mark that is famous** at the time of registration of the domain name, is identical or confusingly similar to **or dilutive** of that mark.
- **With the bad faith intent** to profit from that mark...
- Domain Name registrant could:
 - Lose the Domain Name
 - Pay Money Damages
 - Have Domain Name put on hold
 - 15 U.S.C. 1125 (d)(1)(A)

ACPA Bad Faith Intent to Profit - Factors:

- Applies Traditional US trademark notions of first to use and nature and extent of use.
- Jurisdiction over the “Res” and In Rem
 - Personal Jurisdiction can be difficult to obtain.
- Virginia and California are target states
 - California because ICANN is here.
- Best Practice: Register important Trademarks
 - Note that over 250,000 marks were applied for in 2000 in the US – P.T.O.
 - 2002-2003 – Slow Down
 - Register INTERNATIONALLY
 - Domain Name registrations declined 2002.
 - DOT-COM Trademark registrations seriously declined in 2002.



ACPA Bad Faith Intent- Offers to sell the Domain Name:

- **Offers to sell:** to the trademark owner or others hold the Domain Name for ransom, Especially for more than the cost of registration.
- The **quantity of the Domain Name user's content** that might be "valid" content:
 - 1st Amendment "content" concerns – The "Sucks" cases
- Did the **Domain Name registrant know** the offended trademark?
 - SPORTY'S FARM L.L.C., v.SPORTSMAN'S MARKET, INC,
Docket Nos. 98-7452(L), 98-7538(XAP) U.S.C.A., 2nd Cir.
Feb. 02, 2000, 2000 WL 124389.
 - "Cybersquatting involves the registration as domain names of well-known trademarks by non-trademark holders who then try to sell the names back to the trademark owners."

ACPA & Trademark 2002: Broadening Jurisdiction? "Simon Says - Wine"

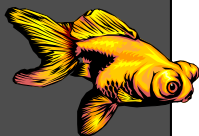
■ **My Simon.com:**

- Melvin Simon founded SPG mall management 40 years ago but did no branding. MySimon.com is an I-Shop for comparison shoppers.
- TRO failed to issue, SPG dropped its request for preliminary inj and in so doing may also say it faces irreparable harm of Trademark infringement. \$Millions in damages awarded by jury was found in MySimon's JMOL motion to be lacking strength.
- Court thus lacks jurisdiction under 28 U.S.C. 1292(a)(1) permitting appeal if a Court denies an injunction. SPG v. mySimon No.01-1444 (UCSA 7th Cir, 3/2002) and dismisses SPG appeal. Trial is pending

■ **Ernesandtjuliogallo.com:**

- Domain Name cannot have "&" other symbols and thus the name is = the winery's famous Trademark.
- Dilution occurs when, after the ACPA case is filed, the Defendants post anti-wine ads.
- Bad faith can be presumed when Defendants warehouse Domain Names of famous marks and lie in with for ACPA to become unconstitutional
 - *E&J Gallo Winery vs. Spider Webs* 129 F. Supp.2d 1033, So.Dist Tx, 5th Cir No. 01-20333, 4/2002

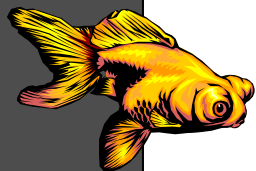
■ **Bottom Line: Register all permutations of a Domain Name to avoid costly litigation.**





ACPA In Rem Action: When The Bad Guy is Not Available

- ❑ 15 U.S.C. 1125 (d) (2) (A) provides for an In Rem action –
- ❑ In Rem - against the property rights in a Domain Name
- ❑ And the Court finds the owner is not able to obtain in personam Jurisd. over person...
- ❑ If you **cannot locate** the Domain Name Registrant ***by notice***
- ❑ Then you may, by **publication** of notice as ordered by a court, obtain in rem jurisdiction in the **district of the Court where the register has its offices.**
- ❑ **Best Practice:** Be sure to follow the *exact statutory requirements* of attempted notice and other steps to insure proper jurisdiction.



No Dilution – In Rem Remedy

- **Porsche redux:** In Porsche's first case, pre- ACPA, it was denied in Rem jurisdiction because under 15 U.S.C. 1125 [c] (dilution) + 1655 (in rem over property) there is no in Rem (Porsche v. allporsche No 99-1804, 99-2152 (4th Cir. 2000)
 - **Now under ACPA**, though Court refused to stretch traditional dilution it succeeds in an In Rem ACPA:
 - 11th hour submittal of Defendant to in personam in California does not divest Court of In Rem in Va.
 - Under 15 U.S.C. 1125(d) Special In Rem is available, no need to allege dilution
 - **Porsche v. *porsche.*...No.01-2073, 01-2028, U.S.C.A. 4th Cir. Aug./2002)**

ACPA Retroactivity, Money Damages

- ***Applies*** to domain names that were registered before and ***used after*** the ***law's*** enactment, ***however***.
- **Injunctive relief** and transfer of the domain name are the *only available remedies if the domain name was registered before the law's enactment.*
- Money Damages (whether actual or statutory) are available only if the domain name was registered after the law's enactment (which was Nov. 29, 1999).
 - Need to show actual loss by lack of “hits” to YOUR site before & after the offending Domain Name!
 - It is easier to show Squatter’s profits made in bad faith.
 - Joseph C. Shields dba Joe Cartoon Co.v. Zuccarini (April 24, 2001 U.S.C.A. 3rd CIR. No. 00-2236)
 - Damages based on “punitive” theory Statutory Damages **\$10,000/Domain Name, x8.**

Is a Domain Name "Property?"

Recent case: Network Solutions Inc vs. Umbro International Va. S. Court 4/21/00 No 991168, suggests that if the URL is a or permits a service, it is *not garnishable* under Virginia's garnishment laws.

- 15 U.S.C. Sec. 1125 (d) allows courts to order the Domain Name register to turn over a URL to a trademark owner.
- No Money Damages in an In rem Action.
- NSI position: URL is service connecting computers by an alphanumeric system and NO MORE.
- May be transferred by contract.
- Porsche Case: a Domain Name is not property that can be diluted **Porsche v. *porsche.*...No.01-2073, 01-2028, U.S.C.A. 4th Cir. Aug./2002**
- Domain Name may take on the Properties of a Trademark
 - Become a source indicator for goods sold, services rendered
 - Become famous and go with the good will (AMAZON.COM)
 - Can be registered as Trademark with the DOT COM

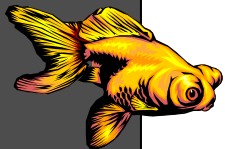
Is a Domain Name "Property?"

SEX.com

■ Kremen vs. Cohen

- Facts: Cohen wanted Kremen's SEX.com, wrote letters to NSI alleging he was transferred the Domain Name with confirmation of Kremen's former administrator.
- Issues – was this CONVERSION?
- Held NO – Historically, the tort of conversion was confined to tangible property. See 5 Witkin, *Summary of California Law*, Torts § 613 (9th ed.1988). "However, California law does recognize "conversion of intangibles *represented by documents*, such as a bonds, notes, bills of exchange, stock certificates, and warehouse receipts." *Id.* Intangible property such as "goodwill of business, trade secrets, a newspaper route, or a laundry list of customers" are not subject to conversion. *Kremen lost millions over 4 years.*
- Does not adopt *Umbro* because *Umbro* was a garnishment and Right in a Domain Name exist apart from NSI agreements.
- It may be: forgery, and conspiracy to convert property RICO and Fraud theories U.S.C.A. 9th Cir. No. C 98-20718 May 30, 2000.

■ Bottom Line – Allege all possible theories not just conversion.



Domain Name Registrants Rights

- Domain Name Registrants have rights to use a name that suits their legitimate needs and to express opinions. The law will continue to strike a balance between conflicting rights.
 - Right to register Domain Name for Sale (*South Bank*)
 - Right to Express opinion [“Sucks” sites] (*Bihari Case*)
 - Right to Comment on a Copyrighted Work (*ACPA CA Business & Professions Code*)
 - Right to hide behind lack of commercialism:
 - Ford: Cases in Point

Domain Name Registrants Rights

Cybersquatters Rights?

1. Selling Domain Names is not Using Them:

- **Auction Domain Names:** The site: www.greatdomains.com is an auction site specializing in auctioning Internet domain names
 - Owners of the site do *not own* the Domain Names.
 - Third parties *sell* such names as “fordparts.com” and “volvoparts.com”
 - Thus, Great Domains cannot be ***trafficking*** in that which it has *no rights to*. Therefore There can also be no cybersquatting.
 - *Ford Motor Co. v. Greatdomains.Com, Inc.* 177 F.Supp.2d 635E.D.Mich.,2001. Dec. 20, 2001.
 - Recall *Universal v Corley et al.*? 111 F. Supp. 2d 348

Lack of Commercialism and Asserted "Art"

2. Cyber art is not infringing:

- Ford sued: Fuckgeneralmotors.com: Dilution and Trademark claims
 - No commercial website – just links to GM called “cyberart”
 - *creative use of links*, no commercial use of the link and “***The essence of the Internet is that sites are connected to facilitate access to information.***”
 - injunction against another person's *commercial use* in commerce of a mark: 15 U.S.C. § 1125 (c) Dilution

To learn more about [FuckGeneralMotors.com](http://www.fuckgeneralmotors.com/) click [here](#).

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Cybersquatters Rights?

Bad Trademarks

3. Use of Generic and Geographical Names

□ **Generic Words do NOT a strong mark make:**

- SouthBank had branches in 5 states BUT:
- “South Bank” is a business center in London
- Web developer had, therefore “legitimate” right to sell “south bank.com” to its customer.
- *SOUTH Bank v. Media Street, Case No. D2001-0294 (WIPO, April, 2001)*
 - Note- the Bank now has the Domain Name.

□ **TV Stations Call Letters**

- KCTS Television Inc. v. Get-on-the-Web Limited Case No. D2001-0154 (4/2001)
- Under principles of **U.K. law**, the same as E.U. law, the mark is not
- confusingly similar.
- The name is ALSO the Kensington & Chelsea Tourism Sites ...No transfer

KCTS
 Kensington & Chelsea
 Tourism Sites

- ▶ Information
- ▶ Attractions
- ▶ Hotels
- ▶ Restaurants
- ▶ Pubs
- ▶ Links
- ▶ Add New Listing



the latest updates and news from KCTS Kensington and Chelsea Tourism Sites
KCTS

Welcome to KCTS @ Kensington & Chelsea Tourism Sites.

The Royal Borough of Kensington and Chelsea is home to some of the most interesting and enjoyable attractions in London. From the ever-hip King's Road in Chelsea to the recently-popularised Notting Hill, the shopping heaven that is Kensington High Street, the fantastic scenery of Kensington Gardens or some of London's top museums that are in South Kensington. The Royal Borough of Kensington and Chelsea is rich in history and architectural interest - yet fashionably modern.

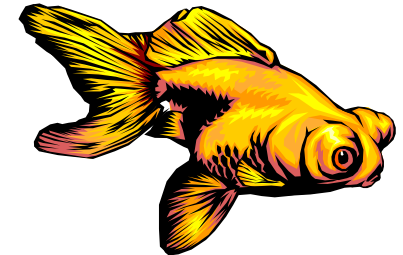
The area has always been closely associated with the British Monarchy : The Albert Hall and the recently restored Albert Memorial dedicated to Prince Albert, the husband of Queen Victoria are located in Kensington - an area that is also associated with the late Princess Diana who lived at Kensington Palace.

The KCTS @ website is dedicated to providing visitors to this area with a wealth of information on hotels, restaurants, pubs & bars, and the many tourist attractions. Click on the menu above or on the left to find out more. Any hotel, restaurant, pub or attraction wanting to be listed please [click here](#).



Bottom Lines:

- Register Trademarks!
- Obtain All permutations of Domain Names
 - Register SUCKS and DAS-HED versions.
- Select marks carefully especially IF they are also to become Domain Names.
- *Keep Litigation costs down – plan way ahead –*
 - ONLINE searches are not enough
 - analysis must be international
 - Include “Common Law.”



Thank You for your attention

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